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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

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8 *Ex parte* DONALD S. KRYSINSKI,
9 PAUL D. ARCHER, and DUANE L. ELMER
10

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12 Appeal 2009-000703
13 Application 09/929,398
14 Technology Center 3600
15

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17 Decided: December 16, 2009
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20 Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and ANTON W.
21 FETTING, *Administrative Patent Judges*.
22 FETTING, *Administrative Patent Judge*.

23
DECISION ON APPEAL

STATEMENT OF THE CASE

Donald S. Krysinski, Paul D. Archer, and Duane L. Elmer (Appellants) seek review under 35 U.S.C. § 134 (2002) of a non-final rejection of claims 1-14, 17-24, 26, and 28, the only claims pending in the application on appeal.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION¹

We AFFIRM-IN-PART.

THE INVENTION

The Appellants invented a way of managing business machines (Specification 1:5-6).

An understanding of the invention can be derived from a reading of exemplary claims 1 and 28, which are reproduced below [bracketed matter and some paragraphing added].

1. A method for automating management of a service contract for a business machine associated with a user, the method comprising steps of:

¹ Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed December 7, 2007) and the Examiner's Answer ("Ans.," mailed February 21, 2008).

1 [1] providing a data capture device proximate to a business
2 machine,
3 the business machine comprising a selection from the
4 group consisting of
5 a copier,
6 a printer,
7 a fax machine,
8 a scanner, and
9 any combination thereof;
10 [2] automatically determining a threshold event associated with
11 the service contract,
12 the threshold event comprising a selection from the group
13 consisting of
14 a usage count for the business machine,
15 a detected error in the business machine,
16 a predetermined time period, and
17 any combination thereof;
18 [3] programming the threshold event into the data capture
19 device,
20 wherein the data capture device monitors the business
21 machine
22 to log an occurrence of the threshold event;
23 [4] receiving notification from the data capture device that the
24 threshold event was logged by the data capture device,
25 wherein the logging of the threshold event triggers the
26 notification; and
27 [5] reporting information related to the service contract
28 electronically and automatically to the user
29 based, at least in part, upon the receiving step.

1 28. An automated business machine management system for
2 business machines of users, the automated business machine
3 management system comprising:

4 [1] a plurality of data capture devices, wherein:

5 each data capture device is coupled to an associated
6 business machine,

7 each associated business machine comprising a selection
8 from the group consisting of

9 a copier,

10 a printer,

11 a fax machine,

12 a scanner, and

13 any combination thereof,

14 each data capture device is configured to monitor its
15 associated business machine and to log monitored events;
16 and

17 each data capture device comprises a wireless
18 transceiver;

19 [2] an operations center in two-way communication with each
20 of the plurality of data capture devices, wherein the operations
21 center is configured to:

22 determine a threshold which triggers a service to be
23 performed by a technician pursuant to a service contract,
24 the threshold comprising a selection from the group
25 consisting of

26 a usage count for the business machine,

27 a detected error in the business machine,

28 a level of supplies for the business machine,

29 a predetermined time period, and

30 any combination thereof;

31 communicates [sic, communicate] that threshold to one
32 of the plurality of data capture devices;

1 receive wireless notification from the one data capture
2 device that the threshold was logged by the one data
3 capture device, triggering the notification;

4 and wirelessly notify the technician to service the
5 associated business machine, wherein the wireless
6 notifying occurs automatically in response to the
7 notification from the data capture device;

8 and

9 [3] a web interface remote to the operations center,

10 wherein the web interface allows users to remotely
11 interact with service contract information and thereby
12 modify the threshold.

13 THE REJECTION

14 The Examiner relies upon the following prior art:

Tarr	5,184,179	Feb. 2, 1993
Motoyama	6,631,247 B1	Oct. 7, 2003

15 Claims 1-14, 17-24, 26, and 28 stand rejected under 35 U.S.C. § 103(a)
16 as unpatentable over Tarr.

17 ARGUMENTS

18 The Appellants argue these claims 1-13 as a group (App. Br. 7-8) and
19 claims 14-28 in various combinations (App. Br. 8-11). In particular, all of
20 the arguments the Appellants make with respect to claims 14-28 apply to
21 claim 28. Accordingly, we select claims 1 and 28 as representatives of the
22 groups. 37 C.F.R. § 41.37(c)(1)(vii) (2008).

23 As to claim 1, the Appellants contend that the art fails to describe
24 limitation [5] reporting information related to the service contract

electronically and automatically to the user based, at least in part, upon the receiving step. App. Br. 7-8.

As to claim 28, the Appellants argue that the art fails to describe (1) an operations center that communicates the service triggering threshold; (2) a data capture device at a business machine with a wireless transceiver that transmits a notification to the operations center when the threshold is triggered; (3) automatic wireless notification of a service technician; or (4) a web interface allowing users to remotely interact with service contract information and thereby modify the triggering threshold. App. Br. 8.

ISSUES

The issue of whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1-14, 17-24, 26, and 28 under 35 U.S.C. § 103(a) as unpatentable over Tarr turns on whether it was predictable to automatically report information as in claim 1 limitation [5] and to use a web interface to modify contract threshold information in a machine as in claim 28 limitation [3].

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to the Prior Art

Tarr

01. Tarr is directed to monitoring one or more paper processors, such as photocopiers, and signaling to the appropriate party information regarding the number of copies made during a

predetermined time interval; when a predetermined number of copies have been made; when service is necessary; and calendar events such as when rental agreements or service contracts have expired. Tarr 1:14-22.

02. Tarr's photocopier monitors diagnostic signals and upon detection of a diagnostic signal, translates the diagnostic signal into a signal usable by an off site end user to determine the condition of the photocopiers. This translated signal is automatically forwarded to the end user upon detection. Tarr 3:24-31.

03. The last such signal is stored for use by the service personnel or in case of disruption in transmission facilities. Additionally, the photocopier monitors the number of counts detected during a predetermined interval and automatically notifies an off site end user when a predetermined number of counts has occurred or what number of counts has occurred in a predetermined real time interval. Tarr 3:31-40.

04. The predetermined interval and count number correspond to billing cycles, preventive maintenance intervals and contract termination intervals, allowing appropriate personnel located at a central station off site from the photocopier being monitored to automatically provide the appropriate service requirement and maintain accurate billing records. Tarr 3:40-47.

05. Tarr's photocopier transmits the count information to the appropriate central station billing computer. Tarr 5:8-13.

06. The reporting period for machine usage can be set to different values. Tarr. 5:

07. The billing center may also send a signal to retrieve the paper count information when after a predetermined time interval that no signal has occurred, the billing center will poll the photocopier to ascertain the status of the copier being monitored and retrieve the reporting information. Tarr 6:27-38.

Motoyama

08. Motoyama is directed to the use of network messages for communicating information to a service center and resource manager regarding the usage of a network resource. Motoyama 2:13-16.

09. Motoyama describes the known use of wireless communication for connecting printers, photocopiers, and facsimile machines. Motoyama 5:9-21.

Facts Related To The Level Of Skill In The Art

10. Neither the Examiner nor the Appellants has addressed the level of ordinary skill in the pertinent arts of systems analysis and programming, contract administration systems and equipment maintenance and billing systems design. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for

testimony is not shown”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985).

Facts Related To Secondary Considerations

11. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Obviousness

A claimed invention is unpatentable if the differences between it and the prior art are “such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

In *Graham*, the Court held that that the obviousness analysis is bottomed on several basic factual inquiries: “[1] the scope and content of the prior art are to be determined; [(2)] differences between the prior art and the claims at issue are to be ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved.” *Graham*, 383 U.S. at 17. *See also KSR*, 550 U.S. at 406. “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 416.

ANALYSIS

Claims 1-13

The Appellants only issue with these claims is whether Tarr describes reporting information related to the service contract electronically and

1 automatically to the user. The Examiner found that Tarr's photocopier
2 transmits the count information to the appropriate central station billing
3 computer. The Examiner realizing Tarr does not explicitly recite the
4 recipient of the information so automatically transmitted as a user, took
5 official notice that the billing operator in Tarr was a user of Tarr's
6 photocopier system, and such transmission implied the predictability of
7 transmission to other users. Ans. 4.

8 The Appellants contend that Tarr's billing information differs from the
9 claimed threshold event notification and that automated transmission of
10 threshold information is not appropriate for official notice. App. Br. 7-8.

11 We agree with the Examiner. The Examiner did not take official notice
12 of automated transmission of threshold information as the Appellants
13 contend. Rather, Tarr explicitly recites several instances of such automatic
14 transmission, such as transmission of billing cycle, preventative maintenance
15 and contract termination threshold events. FF 02 - 04. Tarr also explicitly
16 recites transmitting diagnostic signals to an end user. FF 04. Tarr's
17 transmission of contract billing information at a billing cycle threshold (FF
18 05) coupled with the automatic and electronic transmission of other
19 information to an end user at least shows that the transmission of the service
20 contract threshold information electronically and automatically to the user
21 was predictable.

22 *Claims 14, 17-24, 26, and 28*

23 We find the Appellants' argument that the art fails to describe an
24 operations center that communicates the service triggering threshold
25 unpersuasive. Tarr describes transmitting such threshold information to a

1 central station and to a billing computer. FF 04 - 05. The Appellants point
2 out that the claims require that the operations center not only determines the
3 threshold, but communicates it to one of the data capture devices. We find
4 that Tarr determines when a contractual reporting of data is required at the
5 central station and communicates that to a photocopier when the photocopier
6 has not reported as expected. FF 07.

7 The Appellants' arguments regarding wireless transmission to an
8 operations center and to a technician raise the issue of whether it was
9 predictable to use wireless technology with Tarr. Tarr explicitly describes
10 communicating such threshold information to a central station and service
11 personnel. FF 04 - 05. We find that a central station is an operations center
12 and that service personnel would include technicians.

13 The Appellants contend that the Examiner improperly relied on official
14 notice for the fact that the use of wireless technology was well known at the
15 time of the invention. App. Br. 9-10. The Examiner did rely on official
16 notice for this (Non-Final Rejection 13), and so provided evidence in the
17 form of Motoyama in the Answer (Ans. 14). We agree that Motoyama
18 explicitly describes wireless technology being used for communication with
19 printers, photocopiers and facsimile machines. FF 09. Thus, we find that
20 the Examiner has provided substantial evidence that it was predictable to one
21 of ordinary skill to make Tarr's communications using wireless technology
22 at the time of the invention.

23 The Appellants' final argument is compelling however. First we find
24 that the argument regarding the web interface is applicable to independent
25 claims 14 and 28 but not to claim 22, which does not recited this limitation.

1 The Appellants argue that Tarr does not describe a web interface that allows
2 users to remotely interact with service contract information and thereby
3 modify the threshold. App. Br. 11. The Examiner took official notice of the
4 well known use of web interfaces.

5 While we agree that even at the time of filing, the use of web interfaces
6 was notoriously well known, this does not fully show that the use of such a
7 web interface to modify threshold information in a copier or scanner was
8 known or predictable. The Examiner found that Tarr described modifying
9 the threshold. Ans. 12. The Examiner cites Tarr 5:1-22 describing how the
10 period for counting usage can be modified on a device.

11 The Examiner fails to make any finding as to how such a device could
12 present a web interface. Tarr does not describe anything that would suggest
13 a printer or photocopier would have such an interface or any reason that one
14 would be installed. If the Examiner meant that a web interface would be
15 used remotely, the Examiner has failed to present any evidence that Tarr's
16 modification of threshold parameters such as time period could be modified
17 remotely. The only remote commands Tarr describes sending to the
18 photocopier are those that poll for events that the already existing parameters
19 direct. Thus, as to claims 14 and 28 and the claims 17-21 depending from
20 claim 14, we find the Examiner has failed to present a prima facie case.
21 Because this limitation does not apply to claim 22 and claims 23, 24, and 26
22 depending from claim 22, we find the Examiner has presented a prima facie
23 case for those claims and the Appellants' arguments are unpersuasive for the
24 reasons *supra*.

CONCLUSIONS OF LAW

The Appellants have not sustained their burden of showing that the Examiner erred in rejecting claims 1-14, 22-24, and 26 under 35 U.S.C. § 103(a) as unpatentable over Tarr.

The Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 17-21 and 28 under 35 U.S.C. § 103(a) as unpatentable over Tarr.

DECISION

To summarize, our decision is as follows.

- The rejection of claims 1-14, 22-24, and 26 under 35 U.S.C. § 103(a) as unpatentable over Tarr is sustained.
- The rejection of claims 17-21 and 28 under 35 U.S.C. § 103(a) as unpatentable over Tarr is not sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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